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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/112,131 07/08/98 WALKER

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ART UNIT	PAPER NUMBER
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NGUYEN, C

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/112,131

Applicant(s)
Walker et al.

Examiner
Cuong H. Nguyen

Group Art Unit
2764



☒ Responsive to communication(s) filed on 11/16/98 (the preliminary amendment).

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-190 is/are pending in the application.

Of the above, claim(s) 2-66, 68-112, and 114-176 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1, 67, 113, and 177-190 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 7

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

DETAILED ACTION

1. This Office Action is the answer to the communications received on 11/16/98 & 6/22/99 (the preliminary amendments).
2. Claims 1, 67, 113, 177-190 are pending in this application. Claims 2-66, 68-112, 114-176 were canceled.

Drawings

3. Formal drawings (35 sheets) are received.

Claim Rejections

The following rejections are based on the examiner's best interpretation of the claims.

Double Patenting

4. The non-statutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper time-wise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ 2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

5. Claims 1, 67, 113, 177-190 are rejected under the judicially created doctrine of obvious double patenting over the claims of U. S. Pat. 5,862,223 issued on 1/19/99; since these claims, if allowed, would improperly extend the "right to exclude" already granted in the previous patent.

The main subject matters claimed in the instant application are fully/inherently/obviously disclosed in US Pat. 5,862,223 and are covered by US Pat. 5,862,223; since US Pat. 5,862,223 and the application are claiming common subject matters, as follows:

A. Per claim 1:

Claim 1 of US Pat. 5,862,223 teaches: "An expert matching apparatus for managing communications between an expert having particular qualifications and an end user seeking a solution to an end user request, comprising:

a controller unit for receiving an end user request generated by an end user, the controller unit having a database for storing therein a plurality of qualifications for a plurality of experts, each expert qualification associated with an address corresponding to a particular expert;

means for searching the database to generate a search result containing expert qualifications which correspond to the end user request;

means for guaranteeing payment to the expert for services rendered to the end user;

means for initiating remittance of payments to the experts;

means for transmitting at least a portion of the end user request to the expert address based on the search result;

means for receiving an expert answer corresponding to the end user request transmitted; and

means for transmitting at least a portion of the expert answer to the end user."

In the current application, claim 1 is directed to exactly a similar apparatus (although having a little broader limitation and some clearer explanations to the terms using in this claim), it still has essentially a common direction), comprising similar limitations as listed above.

B. Per claim 67: Claim 67 of US Pat. 5,862,223 teaches: "An expert matching apparatus for managing communications between an expert having particular qualifications and an end user seeking answer to a problem, comprising:

a controller unit for receiving an end user request generated by an end user, the controller unit having a database for storing therein a plurality of expert qualifications, each expert qualification associated with an address corresponding to a particular expert;

means for selecting at least one end user request for evaluation by at least one expert;

means for transmitting at least a portion of the end user request to the expert address based on the end user request selection;

means for establishing a price for an expert answer corresponding to the selected end user request;

means for guaranteeing payment to the expert for services rendered to the end user in response to the end user request;

means for receiving the expert answer responsive to the end user request transmitted; and

means for transmitting the expert answer to the end user."

In the current application, claim 67 is directed to exactly a similar apparatus (although having a little broader limitation and some clearer explanations to the terms using in this claim), it still has essentially a common direction), comprising similar limitations as listed above.

C. Per claim 113: Claim 113 of US Pat. 5,862,223 teaches: "A computer implemented expert matching apparatus for managing communications between an expert having particular qualifications and an end user seeking a solution to an end user request, comprising:

a controller unit for receiving an end user request generated by an end user, the controller unit having a database for storing therein a plurality of expert qualifications, each expert qualification associated with an address corresponding to a particular expert;

means for classifying the end user request;

means for searching the database to generate the search result containing expert addresses which correspond to the end user request classification;

means for searching external databases for search results containing expert addresses which correspond to the end user request classification;

means for authenticating data communications between the controller unit and the expert;

means for transmitting at least a portion of the end user request to the expert based on the search result;

means for receiving at least one expert answer responsive to the transmitted end user request; and

means for transmitting at least a portion of the expert answer to the end user".

In the current application, claim 113 is directed to exactly a similar apparatus (although having a little broader limitation and some clearer explanations to the terms using in this claim),

it still has essentially a common direction), comprising similar limitations as listed above.

The examiner submits that claims 177-179, and 185 contains same limitations as claims 1, 67, 113 above, although they cover a method for managing communication between experts including steps of selecting experts and transmitting an expert qualifications. Therefore same rationales (same analysis and reasoning set forth) for rejection of claims 1, 67, 113 are used again.

US Pat. 5,862,223 discloses a method for managing communications between experts & end users, comprising:

D. Per claims 180, 186: a step of guaranteeing payment to an expert (see '223 claim 1).

E. Per claims 181, 187: a step of requiring the user to prepay (see '223 22:25-29).

F. Per claims 182, 188: a step of checking a credit card account (see '223 22:29-45).

G. Per claims 183, 189: a step of checking a credit card account is performed before transmitting a request to an expert (see '223 22:35-41).

H. Per claims 184, 190: a step of establishing a price for an expert answer corresponding to end user requests (see '223 claims

3, 67)); and if credit available on the credit card account is less than the price of the expert answer, requesting that the end user provide a credit card number of another credit card account (see '223 22:36-41).

Therefore, claims (1, 67, 113, 177-190) contain similar meanings to US Pat. 5,862,223, which are within the breadth and scope of definition claimed in this prior patent. If allowed, these claims of the application, not only would provide patent protection but would also extend patent coverage to the claims 1, 67, 113; already disclosed and covered by the claims in previous patent. Thus, the controlling fact is that patent protection for the method/system, fully disclosed in and obviously covered by the claims of the prior patent, would be extended by the allowance of the claims in this application.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 112

6. Claims 1, 67, 113, 177-179, and 185 are rejected under 35 U.S.C. 112, 2nd paragraph, as failing to particularly point out

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the subject matter which applicant regards as the invention; and these claims left-out essential details that are the objects of this invention (see the specification); such omission amounting to a gap between the elements. The subject matter of the invention is "an apparatus/method for expert matching", a database that contains an address of selected expert, "means for selecting the end user request for evaluation" (this should be a particular/detailed request; hence a definition for this request is required in this claim); "means for transmitting at least a portion of the end user request to an expert based on the end user request" (the address/location of that expert is required to know exactly where to transmit requests) but these important limitations has been left out.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

A. Claims **177-179, 185** are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential element, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted element is: a computer system (in an expert matching apparatus) that executes the method for managing communications between an expert and an end user (these

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methods only work with the assistance of a computer system.)

Therefore, the computer-implemented method/steps as claimed must be performed on a computer system.

B. The remaining claims (180-184, and 186-190), not specifically mentioned, are rejected under 35 U.S.C. 112, second paragraph, for incorporating the defects from their respective parent claims by dependency.

Conclusion

8. Claims 1, 67, 113, 177-190 are rejected.

9. The attached references are considered pertinent to applicant's disclosure.

- US Pat. 5,862,223

In addition, Iliff (US Pat. 5,594,638), Tallman et al. (US Pat. 5,764,923) further explaining more about "managing communications between users" that essentially having the same ideas as this application (see '638 44:21-24, 63:44-52; and '923 the abstract).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Cuong H. Nguyen, whose telephone number is (703)305-4553. The examiner can normally be reached on Monday-Friday from 7-4:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell, can be reached on (703)305-9768.

Any response to this action should be mailed to:

Box Issue Fee

Amendments

Commissioner of Patents and Trademarks

c/o Technology Center 2700

Washington, D.C. 20231


or faxed to: (703) 308-9051, (for formal communications)

Or: (703) 305-0040/308-1396 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)305-3900.

Cuong H. Nguyen
July 31, 1999


James P. Trammell
Supervisory Patent Examiner
Technology Center 2700